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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,539	07/22/2002	Heinrich Gers-Barlag	Beiersdorf 759-HCL	6360
27386	7590	07/14/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			CHONG, YONG SOO	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,539

Applicant(s)

GERS-BARLAG ET AL.

Examiner

Yong S. Chong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's arguments filed on January 20, 2005. Claims 4-6, 15 have been cancelled. Claims 1-3, 7-8, 11-14, 16-20 have been amended. Claims 1-3, 7-14, 16-20 are pending and are examined herein.

Response to Arguments

Applicant's arguments filed on January 20, 2005 have been fully considered but have been found not persuasive.

Applicant admits to the use of phyllosilicate (presumably under the trade name Bentone 34, 38) in the Msika et al. reference (US Patent 5,939,054) in the first paragraph of page 6 in the applicant's arguments. However, applicant argues that there is no motivation for adding phyllosilicate to stabilize a composition. Examiner respectfully would like to direct applicant's attention to col. 3, lines 49-56 of the Msika et al. reference. It states that it's possible to add gelling derivatives of the group Montmorillonites of the Bentone type (38;34), which judiciously introduced in the industrial process, make it possible to optimize the stability of the product. Moreover, they strongly potentiate the solar protection in the highest protection factors and stabilize the protection factor with time. What's more, Bentone 38 can be employed in a range 0.1 to 5% by weight (col. 12, line 49), thus reading range (0.05 to 20%) on the newly amended claim 1.

Thus, the motivation to have modified the composition of Gers-Barlag et al. by adding the phyllosilicate as motivated by Msika et al. is because both references teach cosmetic water-in-oil emulsion compositions. Msika et al. also teach the stabilizing effect of the phyllosilicates, therefore the skilled artisan would have had a reasonable expectation of successfully producing a stable emulsion.

Applicant further argues that the Plaschke et al. (US Patent 6,409,996 B1) and the Suzuki et al. (US Patent 5,145,781) references do not teach the use of flavones in a water-in-oil preparation. Although this is true, the intent of the Examiner is to show additional motivation for adding flavones to the water-in-oil compositions of Gers-Barlag and Msika. As stated in the previous Office Action, Msika et al. use flavonoids in the composition because of its anti-oxidant properties (col. 5, lines 41-48). Furthermore, Plaschke et al. teach the benefits of using flavonoids and flavones as effective UV filters in sunscreen compositions (col. 2, lines 33-50). Hence, there is another reason for Msika et al. to use flavonoids or flavones in the water-in-oil compositions of Gers-Barlag and Msika. Thus, the motivation for using flavonoids or flavones in water-in-oil compositions is because both Msika and Paschke teach sunscreen compositions. A skilled artisan would have had a reasonable expectation of producing a stable product with added anti-oxidant and UV-protection properties.

Finally, applicant argues against the Suzuki et al. (US Patent 5,145,781) without stating any reasons. Again, the reference teaches that alpha-glycosyl rutin has good water-solubility, resistance to light and stability to intact rutin (abstract). The reference also teaches that "alpha-glycosyl rutin is favorably usable as a yellowing agent,

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antioxidant, stabilizer, fading-preventing agent, quality-improving agent, preventive, remedy, UV-absorbent, and deterioration- preventing agent in . . . cosmetics including skin-refining agent and skin-whitening agent” (abstract). Examples B-9, B-13, B-14. and B-15 shows examples of topical compositions comprising alpha-glycosyl rutin. Example B-14 particularly teaches an emulsion.

Given the teaching of using flavone in a cosmetic composition as an antioxidant and UV filter in the combined references, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Suzuki et al. and have been motivated to use alpha-glycosyl rutin because of the expectation of successfully producing a cosmetic composition with UV protection, skin-refining and skin-whitening effects and enhanced stability and anti-oxidant properties.

In light of the applicant's admission that the copending application 09/640,822 will not issue to patent, the obviousness-type double patenting rejection will be withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 7-14, 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lanzendorfer et al. (US Patent 5,952,373).

Lanzendorfer et al. teach a water-in-oil composition (col. 18, lines 65-67) comprising 15% by weight phyllosilicate (trade name Bentone-38, col. 28, lines 13-14), flavone such 0.4% of alpha-glucosylrutin (col. 14, lines 55-56), cosmetic auxiliaries, UV filters (col. 19, lines 5-15), and antioxidants (col. 18, lines 52-55). Thickeners, such as of the Bentone-type, can be present in an amount of 0.5 to 15% by weight (col. 22, lines 5-7). Furthermore, inorganic pigments, for example titanium dioxide may be added (col. 21, lines 14-21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (WO 98/42300) in view of Msika et al. (US Patent 5,939,054) and Plaschke et al. (US 6409996 B1).

Gers-Barlag et al. teach an emulsifier-free water-in-oil type cosmetic composition comprising an oil phase, a water phase, and one or more types of micronized, inorganic metal oxides having amphiphilic properties, and other cosmetic additives (abstract).

Gers-Barlag et al. fail to teach phyllosilicate and flavones, flavonoids, or flavanones. Msika et al. teach water-in-oil suncreening compositions comprising titanium and/or zinc oxide particles. The reference teaches that no additional emulsifiers are added (col. 2, lines 1-9). The reference teaches using a modified phyllosilicate, montmorillonites of the bentone for stabilizing the composition, and shows a formulation comprising 0.1-5% by weight of Bentone 38 (col. 3, lines 49-55; col. 4, lines 24-30; col. 9, line 55 to col. 10, line 14). The example shown in col. 8, lines 50-66 shows 0.5% by weight of alpha-tocopherol acetate, an antioxidant. The reference further teaches that flavonoids also can be used as an antioxidant, which provides the specific motivation to use flavonoids (col. 5, lines 41-46). The reference teaches using titanium dioxide treated with alkylsilane or aluminum hydroxide and stearic acid (col. 2, lines 1-37).

Plaschke et al. teach a flavonoid-containing sunscreen composition (abstract). The invention comprises at least one flavanone and at least one flavone, and is said to provide optimized UV-absorption profile (col. 2, line 21 to col. 4, line 62).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Gers-Barlag by adding the phyllosilicate as motivated by Msika because both references teach cosmetic water-in-oil emulsion compositions. Msika et al. also teach the stabilizing effect of the phyllosilicates, therefore the skilled artisan would have had a reasonable expectation of successfully producing a stable emulsion. The skilled artisan would have been motivated to further add flavonoid as motivated by Msika et al. and Plaschke et al. because both teach sunscreens compositions. Msika et al. teach that flavonoids as antioxidants are well known in the cosmetic art. Plaschke et al. teach that flavonoid-containing sunscreen compositions provide optimized UV-absorption. The skilled artisan would have had a reasonable expectation of successfully producing a water-in-oil sunscreen composition with optimized UV protection.

Claims 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al., Msika et al., and Plaschke et al. as applied to claims 1-5 and 7-12 as above, and further in view of Suzuki et al. (US Patent 5,145,781).

The combined references fail to teach flavone as recited in claims 13-20. Suzuki et al. teach that alpha-glycosyl rutin has good water-solubility, resistance to light and stability to intact rutin (abstract). The reference teaches "alpha-glycosyl rutin is favorably usable as a yellowing agent, antioxidant, stabilizer, fading-preventing agent, quality-improving agent, preventive, remedy, UV-absorbent, and deterioration-preventing agent in . . . cosmetics including skin-refining agent and skin-whitening agent" (abstract). Examples B-9, B-13, B-14. and B-15 shows examples of topical

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compositions comprising alpha-glycosyl rutin. Example B-14 particularly teaches an emulsion.

Given the teaching of using flavone in a cosmetic composition in the combined references, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have looked to the prior arts such as Suzuki et al. and have been motivated to use alpha-glycosyl rutin because of the expectation of successfully producing a cosmetic composition with UV protection, skin-refining and skin-whitening effects and enhanced stability.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

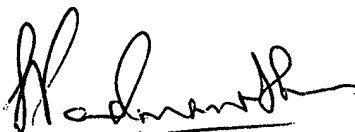
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER